

REMARKS

The Office Action took a broad view of the prior art references and applicant's claim language and particularly the interpretation of the teachings in the *Onoda et al.* reference. To address these issues, applicant is hereby presenting a revised set of Claims 87-101.

The issue of 35 U.S.C. §101 is now believed to be moot.

To assist the Examiner, the support in our current specification for the new claim terminology can be found as follows:

Claim 86

Package area:

Page 31, Line 12 to Page 32, Line 2 of Specification

First playlist information:

Page 39, Line 20 to Page 42, Line 20 of Specification

Claim 87

File replacement/addition:

Page 103, Line 20 to Page 42, Line 25 of Specification

Claim 88

First playlist information:

Page 39, Line 20 to Page 42, Line 25 of Specification

Claim 89

Program:

Page 81, Line 9 to Page 82, Line 4 of Specification

Claim 90

Audio data:

Page 35, Line 25 to Page 36, Line 5 of Specification

Claim 92, 94

Sub-image data:

Page 52, Line 11 to Page 54, Line 16 of Specification

Claim 93, 95

Mounting unit:

Page 29, Lines 5-6 of Specification

Secondary recording medium:

Page 31, Line 18 to Page 32, Line 15 of Specification

Generating unit:

Page 32, Lines 3-7 of Specification

Downloading unit:

Page 32, Lines 7-9 of Specification

Playback unit:

Page 43, Line 1 to Page 46, Line 25 of Specification

Update kit:

Page 32, Lines 10-15 of Specification

Second playlist:

Page 39, Line 20 to Page 42, Line 25 of Specification

Claim 96

File replacement/addition:

Page 103, Line 3 to Page 104, Line 12 of Specification

Claim 97

Second playlist information:

Page 39, Line 20 to Page 42, Line 25 of Specification

First multiplexer:

Page 29, Line 9 to Page 30, Line 10 of Specification

Second multiplexer:

Page 32, Lines 21-24 of Specification

Synchronous playback:

Page 43, Line 1 to Page 46, Line 25 of Specification

Claim 98

Mounting step:

Page 29, Lines 5-6 of Specification

Secondary recording medium:

Page 31, Line 18 to Page 32, Line 15 of Specification

Generating step:

Page 32, Lines 3-7 of Specification

Downloading step:

Page 32, Lines 7-9 of Specification

Playback step:

Page 43, Line 1 to Page 46, Line 25 of Specification

Update kit:

Page 32, Lines 10-15 of Specification

Second playlist:

Page 39, Line 20 to Page 42, Line 25 of Specification

Claim 99

File replacement/addition:

Page 103, Line 3 to Page 104, Line 12 of Specification

Claim 86

The invention recited in new Claim 86 is directed to a method for recording a first digital stream (e.g. subtitle data) and first playlist information into a recording medium that is a separate medium from a read-only disc (such as a BD-ROM) having a second digital stream (e.g. AV data of a movie) recorded therein. The following is one characterizing feature of the present invention. The first playlist information is used instead of the second playlist information recorded on the read-only optical disc and defines a playback path comprising a playback section of the first digital stream and a playback path of the second digital stream.

The use of the first playlist information renders it possible to newly define a playback section of the second digital stream recoded on the read-only optical disc (e.g. AV data of a movie) and synchronously play back the second digital stream with the first digital stream (e.g. subtitle data). In this way, the second digital stream recoded on the read-only optical disc (e.g. AV data of a movie) is used in an improved and developed manner. For example, a different version of a movie may be generated and provided to users after an initial distribution of the movie on read-only optical medium. This is done by generating a suitable playlist information and a first digital stream, without requiring any prior preparation made at the time of the initial movie distribution (see Page 27, Line 12 to Page 28 Line 5 of our specification) as follows:

Playback sections on a BD-ROM formed from groupings of CELL information, stream management information, and AV stream are called "CELLs." Logical playback units on a BD-ROM that are formed from groupings of PL information, stream management information and AV stream are called "PlayLists" (abbreviated as "PL"). Movie productions recorded on a BD-ROM are structured in these logical playback units (PLs). Since movie productions on a BD-ROM are structured in logical playback units, it is possible to easily create, as distinct from the main movie production, movie productions from scenes in which only certain characters appear, for instance, by defining the PLs specifying only such scenes in which those characters appear. Figure 11 shows an example in

which a PL (the PL information #2) different from the PL information (the PL information #1) shown in FIG. 10 is defined.

The greatest merit of static scenarios is being able to increase the range of a moviemaker's expression, since the variations of a movie production increase simply by defining different pieces of PL information.

Similarly, another variation of the movie suitable for the specific culture of a region may be additionally provided with subtitles in the language of the region not available in the original optical disc.

Claim 87

The first digital stream and first playlist information are contained in files that are accessed by file names not included in the file layout of the read-only optical disc. By placing the first digital stream and playlist information of the first digital stream in such files and by defining the first playlist information to indicate the names of the individual files containing the first digital stream and the second digital stream, the first and second digital streams are associated with each other. Since the first playlist information can be defined in a format based on a virtual package composed of the first and second digital streams, the correspondence between the first and second digital streams are defined in a manner to ensure the compatibility in syntax with the playlist information recorded on the optical disc. This advantage minimizes the effort of authoring required to make an additional version of the movie, which improves the editing producibility at movie studios.

Claim 92

This invention is directed to a playback apparatus and one feature of the playback apparatus is that the playback is executed according to the second playlist information. The second playlist information is recorded, with the second digital stream (e.g. subtitle data), on a

recording medium provided separately from the optical disc storing the first digital stream (e.g. AV data of a movie) and used instead of the playlist information recorded on the optical disc. The use of the second playlist information renders it possible to newly define a playback section of the first digital stream recoded on the optical disc (e.g. AV data of a movie) and synchronously play back the first digital stream with the second digital stream (e.g. subtitle data). In this way, the first digital stream recoded on the optical disc (e.g. AV data of a movie) is used in an improved and developed manner. For example, a different version of a movie may be generated and provided to users after distribution of the movie on optical medium and this is done simply by generating suitable playlist information and a second digital stream, without requiring any preparation made at the time of the movie distribution (see Page 27, Line 12 to Page 28 Line 5 of the English specification). Similarly, another variation of the movie suitable for the culture of a region may be additionally provided with subtitles in the language for the region not available in the optical disc.

In summary, a feature of the playback apparatus recited in Claim 92 is that the playback is executed in accordance with the second playlist information.

Claim 93

The playback apparatus recited in Claim 93 upgrades the optical disc by reading the file layout of the optical disc to the memory and performing file replacement and/or file addition to the file layout of the optical disc. That is, without the need to change the contents of the optical disc, one or more files recorded on the optical disc may be replaced with a new file (new files) and/or one or more files may be added after the distribution of the optical disc. In addition, if any defect is found in the optical disc after distribution, the defect may be remedied without

collecting the optical disc. The risk that the optical discs may need to be corrected and replaced in the future, is removed by the present invention.

The Office Action rejected Claims 68, 70-75 and 78-85 as being completely anticipated by *Onoda et al.* (Japanese Laid-Open Publication 2002/247562).

“[A]nticipation by inherent disclosure is appropriate only when the reference discloses prior art that must *necessarily* include the unstated limitation. . . .”

Transclean Corp. v. Bridgewood Services, Inc., 290 F.3d 1364, 62 USPQ2d 1865 (Fed. Cir. 2002)

The *Onoda et al.* reference (JP 2002-247526) discloses a playback device for playback of a video stream stored on an optical disc, synchronous with an audio stream and/or a sub-picture stream that are supplied from an external device. The optical disc mentioned is a DVD video disc. The stream data stored on the optical disc is read by an optical pickup mechanism (13). An external stream data can be read by an external input unit 62 from a disc medium 63, a semiconductor memory medium 64, or a communications medium (e.g., network, etc.).

The stream data read from the external source has a packet structure shown in Figure 3. In order to establish a synchronism with the video packet of the DVD video disc that is currently being played, the packet header of the external stream contains a presentation time stamp (PTS). The internal system clock reference of the device is therefore supplied also to the reading control unit 61. (See Paragraph [0037]) Just as the video packet is read within the device in synchronism with the reference time (system clock), the external input packet (audio packet) is also read from the external input unit 62 in synchronism with the reference time within the device.

In the case where a stream of data supplied from the external device represents audio in a language different from the audio language recorded on the DVD video disc 11, the user can view playback of the video recorded on the DVD video disc 11 in synchronism with the audio of that different language. In the case where a stream of data supplied from the external device represents subtitles in a language different from the subtitle language recorded on the DVD video disc 11, the user can view playback of the video recorded on the DVD video disc 11 in synchronism with the subtitles of that different language. (See Paragraph [0036])

A careful review of Figure 1 discloses that the decoding control unit 61 is connected to the SP decoder 40 and the lines of communication disclosing an input and an output from this SP decoder 40, show audio buffer 18 and the sub-picture buffer 19 inputs into the SP decoder along with information from the decoding control unit 62 connected to the external stream of data. Note, the only outputs from the SP decoder 40 are directed to the audio decoder 32 and the SP decoder 33.

As can be readily determined, the video buffer 17 that is receiving the video data from the separation unit is not connected to the SP decoder, but rather is only connected to a video decoder 31. Thus, the video decoder is not configured to receive data from any other medium than the optical disk loaded in the playback device.

Accordingly, from Figure 1 alone, the hardware/software structure that is schematically disclosed teaches that a constant video stream from a DVD disk that is being played, is not interrupted, and that the only supplemental data that can be inserted from an external source is audio data and SP (sub-picture) data and not video data such as AV clips.

In summary, it is clear that the *Onoda et al.* reference cannot be an anticipatory reference since it does not recognize the problem addressed and solved by our present invention, and

certainly fails to teach any structure that would be capable of providing the solution of our present invention.

“In relying upon a foreign patent to reject a claim, the Patent Office must construe the disclosure of the foreign reference strictly, and restrict the reference to what is clearly and definitely disclosed.”

CITC Industries, Inc. v. Manow International Corp., 193 U.S.P.Q. 3656, 368 (S.D.N.Y. 1996).

Finally, Claims 69 and 76 were also rejected as obvious under 35 U.S.C. §103 over the *Onoda et al.* publication in view of *Hamasaka et al.* (U.S. Patent No. 7,356,247).

The inventions recited in the new independent claims and dependent claims of the present application have a characterizing feature of playlist information that can show a correspondence between files in different mediums. It is believed that the choice of claim language and necessary interpretation of that claim language as fully supported by our current specification, more than adequately distinguishes over any combination of the references of record.

The *Onoda et al.* reference discloses a technique of synchronous playback of a video stream recorded on an optical disc with only audio and/or sub-picture streams supplied from a source external to the playback apparatus. However, a notable difference lies in how an external stream to be synchronously played with the video playback is selected. According to the *Onoda et al.* reference, the selection of a stream to be played in synchronization with a video stream is made only in accordance with information recorded on the optical disc (PGCI). More specifically, PGCI indicates stream numbers 1-M identifying different audio streams recorded on the optical disc. If a stream number N selected by a user operation falls within the range of 1-M, playback of a video stream is executed in synchronism with an audio stream also recorded on the optical disc. If the stream number N is greater than M ($N > M$), the video playback is

executed in synchronism with an audio stream supplied via a network or another medium (see Paragraph 0053 of *Onoda et al.*).

As disclosed in Paragraph 0025 of the *Onoda et al.* reference, the alleged correspondence information (i.e. presentation time stamp) is described within individual packs. Each pack is equivalent to 2,048 bytes of data and attached with a pack header. However, a presentation time stamp cannot correspond to the playlist information according to the present claimed invention and thus does not show our correspondence between files on an optical disc and files on a secondary recording medium.

In defining an invention, a difficulty arises in using a two-dimensional verbal definition to represent a three-dimensional invention. To provide protection to an inventor and notification to the public, a proper interpretation of terms utilized in the claims must be adhered to in order to enable an appropriate evaluation of the invention and its scope relative to cited prior art.

Thus, not only should the concept of the invention be found in the prior art, but further, any cited structural elements in a prior art reference should be performing the same function with the same technical understanding to a person of ordinary skill in the field as the invention claims at issue.

Secondly, what is shown by the correspondence is different. According to Paragraph 0026 of the *Onoda et al.* reference, the presentation time stamp disclosed therein is time information and the playback apparatus starts playback of original video, new audio, and new sub-image data contained in a pack at a time when the time indicated by the presentation time stamp attached to the pack is reached. As clarified above, the presentation time stamp of the *Onoda et al.* reference is only time information for establishing synchronization. That is, it

cannot be construed to show, unlike the playlist information of the present invention, a direct correspondence between files on an optical disc and files on a secondary recording medium.

Thirdly, according to Paragraphs 0017-0019 of the *Onoda et al.* reference, the information showing the correspondence is used when the read controller 61 judges whether a stream of data from the external input unit 62 is to be supplied to the selector 40 or a stream of data read from the optical disc is to be supplied to the selector 40. More specifically, the presentation time stamp attached to the external stream data is compared with the presentation time stamp of the video stream data to supply a corresponding external stream to the selector. According to the *Onoda et al.* reference, the information showing the correspondence is used to select one of separate streams of audio and sub-picture data that is to be played in synchronism with the video playback. That is to say, the information showing the correspondence is not used as playlist information showing correspondence between files and thus not used to read corresponding files from an optical disc and a secondary recording medium.

The present invention is distinguished from the *Onoda et al.* reference at least with respect to the above three points and thus the *Onoda et al.* reference cannot be relied upon to teach the playlist information showing the correspondence between files on an optical disc and files on a secondary medium.

As disclosed in Column 21, Line 54 to Column 22, Line 5, the *Hamasaka* reference is directed to a higher hierarchal level technique of allowing a user to start playback from an entry point.

When an entry point marking command is received from the user, the system controller adds an entry to the user-defined entry, point table (step 5324). If the user wants to set an entry

point to a location other than the original entry points, the starting and end points of the stream interval to be marked by an entry point must be specified.

As is clear from the above description, the portion of the *Hamasaka* reference cited by the Office Action merely discloses a process of adding an entry point to an entry map according to user input. Obviously, this disclosure does not relate to the playlist information showing the correspondence of files and is not related to a control operation to control according to the playlist information a reading by the reading unit to update an original movie production. The *Hamasaka* reference in combination with the *Onoda et al.* reference cannot render the present invention obvious under 35 U.S.C. §103.

As described above, neither the *Onoda et al.* nor *Hamasaka* references can be construed to render obvious the concept of a first playlist information showing a correspondence between a second digital stream recorded on a read-only recording medium and a first digital stream recorded on a separate recording medium from the read-only medium to execute synchronous playback of the first and second digital streams based on the first playlist information.

In addition, any combination of references lacking the disclosure of the playlist information showing a correspondence between files on the respective mediums cannot render it obvious to arrive at the present invention. It is, therefore, not appropriate to reject the present invention as being obvious over the *Onoda et al.* and *Hamasaka* references. It is further submitted that the present invention allows an editor to produce and distribute a different version of a movie (such as a version with subtitles in a different language or a version made to be suitable to the culture of a specific region) having been distributed earlier in the form of optical disc, even if such a version is not planned at the time of the initial distribution. This significant

effect is not achieved by either the *Onoda et al.* reference nor the *Hamasaka* reference, which further proves the inventiveness of the present invention.

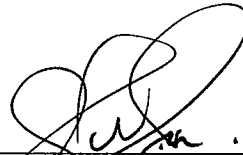
Accordingly, on this record, Appellants have established that one of ordinary skill in this art would not have combined the teachings of Barbee, Esler, and DeSisto in a manner to arrive at the claimed apparatus. *See, e.g., KSR Int'l C. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1741 (2007) (“it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does”); *In re Kahn*, 441 F.3d 977, 985-88 (Fed. Cir. 2006); *In re Rouffet*, 149 F.3d 1350, 1358 (Fed. Cir. 1998) (“hindsight” is inferred when the specific understanding or principal within the knowledge of one of ordinary skill in the art leading to the modification of the prior art in order to arrive at appellant’s claimed invention has not been explained); *In re Fritch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992) (“The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.”); *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 1050-54 (Fed. Cir. 1988); *In re Keller*, 642 F.2d 413, 425 (CCPA 1981) (“the test [for obviousness] is what the combined teachings of the references would have suggested to those of ordinary skill in the art”).

It is believed the present application is now allowable and an early notification of the same is requested.

If the Examiner believes that a telephone interview will assist in the prosecution of the present case, the undersigned attorney can be contacted at the listed phone number.

Very truly yours,

SNELL & WILMER L.L.P.



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